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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---|------------------------------------|
| 10/627,724 | 07/28/2003 | Timothy Effrem | MAS001 | 3513 |
| <div>7590 10/17/2007 THE LAW OFFICES OF ROUZ TABADDOR, ESQ. 1745 PENNSYLVANIA AVE. N.W., SUITE #205 WASHINGTON, DC 20006</div> | | | <div>EXAMINER TALBOT, MICHAEL</div> | |
| | | | <div>ART UNIT 3722</div> | <div>PAPER NUMBER</div> |
| | | | <div>MAIL DATE 10/17/2007</div> | <div>DELIVERY MODE PAPER</div> |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/627,724

Applicant(s)

EFFREM, TIMOTHY

Examiner

Michael W. Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 and 20-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 June 2007 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 13 and 20-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claims a chuck effective capacity of "about 5 mm to above". The claimed range is indeterminable since Applicant's own specification does not clearly enable the claimed limitation. Specifically on page 2 in the section entitled "Summary of the Invention", lines 4 through 5, the specification discloses a chuck effective capacity of 0-6.35 mm and again on page 3 in the same section entitled "Summary of the Invention", lines 4 through 5, the specification discloses a chuck effective capacity of "up to at least 6.35 mm". As a result, it has been determined that the specification does not enable the claimed limitation to extend to an infinite range above 6.35 mm as the claims now permit.

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Furthermore, Applicant's proposed amendment filed 10 January 2007 to the specification to include the following: "In another embodiment, the chuck jaws may be adjusted by a chuck key and the chuck has an effective capacity of about 5 mm to above" adds further confusion to the already submitted specification (see above paragraph for examples) which clearly state a completely different range for the chuck effective capacity. This further supports the fact that the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. In addition, it has been determined that the chuck effective capacity range of 0-6.35 mm disclosed on page 2, lines 4 through 5, in the section entitled "Summary of the Invention" renders a "lack of criticality" since the range incorporates the possibility of a "0" capacity.

(This item was not discussed during 26 September 2007 phone interview, but must be addressed within forthcoming proposed amendments)

5. In addition, the specification on page 6, lines 2-3 states: "the second portion B has a diameter D which is less than the diameter of the first portion." However the ranges recited within independent claims 13 (first portion: 25.5 mm to 27.0 mm and second portion: 25.2 mm and 25.6 mm) and 20 (first portion: 25.5 mm to above and second portion: 25.2 mm and 25.6 mm), permits for the first portion to have a diameter less than that of the second portion which is not supported by the original disclosed specification and figures. Again, this further supports the fact that the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 13 and 20-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Regarding claims 13 and 20-30, the claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claims a chuck effective capacity of "about 5 mm to above". The claimed range is indeterminable since Applicant's own specification does not clearly enable the claimed limitation. Specifically on page 2 in the section entitled "Summary of the Invention", lines 4 through 5, the specification discloses a chuck effective capacity of 0-6.35 mm and again on page 3 in the same section entitled "Summary of the Invention", lines 4 through 5, the specification discloses a chuck effective capacity of "up to at least 6.35 mm". As a result, it has been determined that the specification does not enable the claimed limitation to extend to an infinite range above 6.35 mm as the claims now permit.

Furthermore, Applicant's proposed amendment filed 10 January 2007 to the specification to include the following: "In another embodiment, the chuck jaws may be adjusted by a chuck key and the chuck has an effective capacity of about 5 mm to above" adds further confusion to the already submitted specification (see above paragraph for examples) which clearly state a completely different range for the chuck effective capacity. This further supports the fact that the claim(s) contains subject matter which was not described in the specification in

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such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

9. In addition, the specification on page 6, lines 2-3 states: "the second portion B has a diameter D which is less than the diameter of the first portion." However the ranges recited within independent claims 13 (first portion: 25.5 mm to 27.0 mm and second portion: 25.2 mm and 25.6 mm) and 20 (first portion: 25.5 mm to above and second portion: 25.2 mm and 25.6 mm), permits for the first portion to have a diameter less than that of the second portion which is not supported by the original disclosed specification and figures. Again, this further supports the fact that the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

10. Regarding claim 20, the phrase "a diameter in the range of about 25 mm to above" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

11. Regarding claim 20, the phrase "a diameter in the range of about 25.2 mm to about 25.6 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the second portion shrouded wall diameter. See MPEP § 2173.05(b).

12. Regarding claim 21, the phrase "the length of the first portion is in the range of about 35 mm to about 45 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the first portion shrouded wall length. See MPEP § 2173.05(b).

13. Regarding claim 22, the phrase "the length of the first portion is about 40 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the first portion shrouded wall length. See MPEP § 2173.05(b).

14. Regarding claim 23, the phrase "the diameter of the first portion is about 26 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

15. Regarding claim 24, the phrase "the thickness of the shrouded wall is in the range of about 0.7 mm to about 1.2 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the shrouded wall thickness. See MPEP § 2173.05(b).

16. Regarding claim 25, the phrase "the thickness of the shrouded wall is about 0.7 mm - 0.8 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the shrouded wall thickness. See MPEP § 2173.05(b).

17. Regarding claim 27, the phrase "the second portion has a length in the range of about 40 mm to about 85 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the second portion shrouded wall length. See MPEP § 2173.05(b).

18. Regarding claim 28, the phrase "the second portion has a length of about 62 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the second portion shrouded wall length. See MPEP § 2173.05(b).

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19. Regarding claim 29, the phrase "the second portion has a diameter of about 25.4 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the lower and upper limits of the second portion shrouded wall diameter. See MPEP § 2173.05(b).

Allowable Subject Matter

20. Patentability of claims 13 and 20-30 can not be determined at this time due to the rejection(s) under 35 U.S.C. 112, 1st paragraph and 35 U.S.C. 112, 2nd paragraph set forth in this Office action.

Response to Arguments

21. Applicant's arguments filed 13 June 2007 have been fully considered but they are not persuasive.

22. The application is filled with 35 U.S.C. 112, 1st paragraph and 35 U.S.C. 112, 2nd paragraph issues that **must** be addressed and resolved prior to further prosecution of the claims based upon the merits.

23. In response to applicant's argument that the disclosed drawings and specification clearly teach the stepped configuration of the shroud wall of applicant's invention, it is noted that the features upon which applicant relies (i.e., the diameter of the first portion (E) of the shroud wall is greater than the diameter of the second portion (D) of the shroud wall) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

24. It is noted within the background of the specification, (first on page 1, second paragraph, last two lines and again on page 2, 1st full paragraph, lines 2-4), that it is critical for the exterior diameter of the handpiece to remain at a maximum diameter of 1 inch. This is to allow for proper

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assembly within industry standard handpiece holders, jigs and fixtures as well as for ease of handling by the user when used freehand. However the claims as recited continue to claim a chuck effective capacity of "about 5 mm to above". The claims conflict and contradict the background of the disclosed specification and add extreme confusion, since the claims have been written to cover a range with an infinite upper end (about 5 mm to above) when the intended environment for the claimed handpiece has a critical maximum diameter of 1 inch.

Conclusion

25. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MWT
Examiner
27 September 2007


MONICA CARTER
SUPERVISORY PATENT EXAMINER